

REMARKS

This amendment is identical in substance to the Proposed Amendment faxed to Examiner Reimers on July 1, 2005. In view of the Examiner's helpful comments by voice mail that the proposed amendment put the claims in condition for allowance over Neumann but raised new issues requiring further consideration or search, applicant is filing a RCE concurrently herewith to allow full consideration of this amendment on its merits.

Applicant thanks the Examiner for withdrawing the objection to the specification and for her helpful comments in a telephone message left in response to the request by the undersigned for a personal interview. The amendments presented above put this application in condition for allowance.

Claims 3 and 4 again stand rejected as anticipated by Neumann U.S. Patent Publication No. 2002/0082695 (Neumann). The Examiner again kindly provided on page 3 of the Action a graphical representation of where she found each of the claim elements disclosed in the reference. Applicant respectfully traverses this rejection.

The Examiner seems to base most of her logic on the observation (set forth in the paragraph bridging pages 3 and 4 of the Action) that claim 3 does not claim the cervical prosthesis, insertion instrument and holder as separate components. This interpretation is unreasonable since it is contrary to the understanding of the terms cervical prosthesis, insertion instrument and holder as they would be broadly interpreted by persons skilled in the art in the context of the claims as they appeared prior to the amendments above. The amendments to claim 3 above simply reflect this aspect of the invention and eliminate redundant verbiage.

The first part of claim 3 read prior to the amendments above, "A device for implanting cervical prostheses, comprising a cervical prosthesis, an insertion instrument including a pair of gripping members which are configured to grip the cervical prosthesis on opposite sides of the cervical prosthesis, and a holder configured to receive the cervical prosthesis with an exact fit." The whole point of a device for implanting a cervical prosthesis is to implant the prosthesis and

not to leave other components in place. Persons skilled in this art know that one does not leave an insertion instrument in place when a cervical prosthesis is implanted, so the insertion instrument and the cervical prosthesis must by their very nature be separate. This understanding is confirmed by the fact that the insertion instrument has gripping members for gripping the prosthesis – if the prosthesis and the insertion instrument were not separate, then there would be no need for such gripping members. In addition, as a matter of language, the holder and cervical prosthesis must be separate because otherwise the holder could not be configured to *receive* the cervical prosthesis with an exact fit if the cervical prosthesis and the holder were not separate to begin with. Thus, the Examiner ‘s reading of claim 3 as not requiring the insertion instrument and holder to be separate from the cervical prosthesis, if, indeed, that is how she reads claim 3, is legally incorrect.

The language of claim 3 prior to amendment also shows that the insertion instrument and the holder are separate from one another. First, applicant intentionally used a comma to separate the description of the insertion instrument from the description of the holder. This may be a small point in the claim language, but it is intentional and was intended to make it clear that the holder and the insertion instrument are separate. The Examiner also failed to note that if the insertion instrument and holder were intended to form a single structure, applicant would have inserted the word “and” *before* “insertion instrument” and *not* included the comma after “insertion instrument,” to make it clear that the insertion instrument and the holder could be part of the same structure. The separate nature of the insertion instrument and holder in this application is apparent from Fig. 3, for example. As noted above, applicant has amended claim 3 to state explicitly what was already implicit in the claim language.

Once the Examiner construes the claims properly in accordance with their express language, the basis for the rejection evaporates, for the reasons set forth by applicant in the previous response. As explained previously, Neumann’s element 29 is disclosed in paragraph [0031] to be the lower fork of a holder 26 that is part of the insertion instrument and is designed

to be complementary to the holder grooves 17 on the sleeve part of the implant. Although Neumann calls grooves 17 “holder grooves,” they are not grooves on a holder but are instead grooves on sleeve part 2 of the implant itself. See paragraphs [0027] and [0030]. There is no holder in Neumann’s device that is separate from the insertion instrument.

As applicant also pointed out, Neumann’s device is not capable of functioning in accordance with the “wherein” clause of claim 3, which defines the structural relationship among the cervical prosthesis, the holder and the insertion instrument. This portion of claim 3 states that “the gripping members and the prosthesis have complementary projections and recesses * * * which are configured to be brought into engagement and be released from one another *by relative movement of the gripping members in a direction transverse to a longitudinal axis of the insertion instrument and transverse to the anterior-posterior direction of the prosthesis.*” On page 2 of the Action, the Examiner reads the claim as requiring only that the gripping members be configured to grip the prosthesis on opposite sides, which does not correspond to the structural configuration specified by this language in claim 3. The Examiner’s interpretation of this aspect of claim 3 is unreasonable since she does not give any weight to the italicized language. The recesses on Neumann’s prosthesis and the grooves on Neumann’s device run in the same, anterior-posterior direction, so the grooves do not and cannot function to allow engagement and release of the prosthesis in a direction transverse to the anterior-posterior direction. As a result, Neumann neither identically discloses the subject matter of claims 3 and 4 nor provides a motivation to make the claimed implanting device.

Since the claims are patentable over the prior art, early action allowing claims 3 and 4 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to

Deposit Account No. 03-1952 referencing Docket No. **246472005300**.

Respectfully submitted,



Barry E. Bretschneider
Registration No. 28,055

Dated: July 7, 2005

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7743
Facsimile: (703) 760-7777